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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,217	06/13/2001	Kathleen Danenberg	11220/129	6207

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 10/29/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,217

Applicant(s)

DANENBERG, KATHLEEN

Examiner

Jeffrey Fredman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9, 10. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 6-26 in Paper No. 12 is acknowledged.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Double Patenting

3. Claims 6-26 of this application conflict with claims 6-26 of Application No. 09/842,111. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
4. Claims 6-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-26 of copending Application No. 09/842,111. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim Rejections - 35 USC § 112 – Scope of Enablement

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 6-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for some internal controls, does not reasonably provide enablement for B-actin as an internal control. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described by the court in *In re Wands*, 8 USPQ2d 1400 (CA FC 1988). *Wands* states at page 1404,

"Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary,

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(2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims."

The nature of the invention

The claims are drawn to a method of performing RT-PCR using B-actin as an internal control. The invention is is an class of invention which the CAFC has characterized as "the unpredictable arts such as chemistry and biology." *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001).

The breadth of the claims

The claims encompass a method of determination of the state of the DPD gene in patients by analyzing the mRNA of the DPD gene as compared to B-actin. The method broadly encompasses the use of the method in any cell type, in any tumor type, in any type of mammalian patient. Further, the cells undergoing the test may be subject to any of a variety of different conditions depending upon the particular patient studied, with insulin dependent patients, for example receiving daily doses of a compound which significantly alters cellular metabolism while cancer patients may be receiving chemotherapeutic treatments, pain medicine for surgery, corticosteroids to reduce trauma associated with surgery which themselves significantly impact cellular metabolism or any of a number of other complicating factors which impact the expression of cellular markers such as B-actin.

Quantity of Experimentation

The quantity of experimentation in this area is large since there is significant variability in the expression of B-actin depending upon the cell type, cell environment

as discussed above regarding chemotherapeutic or other treatments which is an inventive, unpredictable and difficult undertaking in itself, and efficacy of B-actin as a control would need to be demonstrated in a variety of different cell type models. This would require years of inventive effort, with each of the many intervening steps, upon effective reduction to practice, not providing any guarantee of success in the succeeding steps.

The unpredictability of the art and the state of the prior art

The art teaches that B-actin is an unsuitable control for RT-PCR. Specifically, Selvey et al state "These results clearly demonstrate the unsuitability of B-actin as an internal control for gene expression studies (page 310, column 1). The prior art also teaches the unsuitability of B-actin when Willhauck states that "Second, the increasing number of GAPDH and B-actin retropseudogenes, which can be amplified even if mRNA specific primers were designed, can lead to an overestimation of the RT efficacy. Third, because the expression of housekeeping genes is regulated, the level of expression may be influenced by many factors (page 656, columns 1 and 2)". Thus, the ordinary practitioner would not expect B-actin to function as a successful internal control in view of the teachings in the art that B-actin is unsuitable.

Working Examples

The specification has a working example using FPE tumor cells, but the working example was not checked to determine whether the internal control was, in fact, unchanged itself between the samples.

Guidance in the Specification.

The specification, while suggesting the use of internal controls and B-actin in particular, did not teach how to verify whether the B-actin was, in fact, functioning as a proper internal control .

Level of Skill in the Art

The level of skill in the art is deemed to be high.

Conclusion

In the instant case, as discussed above, the level of unpredictability and the teaching against the use of B-actin by the art is opposed to patentability (see Selvey and Willhauck). The specification provides one with no written description or guidance that leads one to a reliable method using B-actin as an internal control. One of skill in the art cannot readily anticipate the effect of a change within the subject matter to which the claimed invention pertains. Further the specification does not provide guidance to overcome art recognized problems in the use of B-actin as a control as broadly claimed (i.e encompassing a method in any cell under any treatment in any conditions). Thus given the broad claims in an art whose nature is identified as unpredictable, the unpredictability of that art, the large quantity of research required to define these unpredictable variables, the lack of guidance provided in the specification, the presence of a working example which does not address the issue of the efficacy of the control and the negative teachings in the prior art balanced only against the high skill level in the art, it is the position of the examiner that it would require undue experimentation for one of skill in the art to perform the method of the claim as broadly written.

Claim Rejections - 35 USC § 112 – Written Description

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 6-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All of these claims encompass nucleic acids which are different from those disclosed in the specific SEQ ID Nos, which include variants for which no written description is provided in the specification. Specifically, the claims encompass "substantially identical" oligonucleotides, but the specification give only certain specific oligonucleotides as examples of such primers and probes.

It is noted in the recently decided case The Regents of the University of California v. Eli Lilly and Co. 43 USPQ2d 1398 (Fed. Cir. 1997) decision by the CAFC that

"In claims to genetic material, however, a generic statement such as "vertebrate insulin cDNA" or "mammalian insulin cDNA," without more, is not an adequate written description of the genus because it does not distinguish the claimed genus from others, except by function. It does not specifically define any of the genes that fall within its definition. It does not define any structural features commonly possessed by members of the genus that distinguish them from others. One skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is. See *Fiers*, 984 F.2d at 1169- 71, 25 USPQ2d at 1605- 06 (discussing Amgen). It is only a definition of a useful result rather than a definition of what achieves that result. Many such genes may achieve that result. The description

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requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372- 73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material. "

It is noted that in Fiers v. Sugano (25 USPQ2d, 1601), the Fed. Cir. concluded that

"...if inventor is unable to envision detailed chemical structure of DNA sequence coding for specific protein, as well as method of obtaining it, then conception is not achieved until reduction to practice has occurred, that is, until after gene has been isolated...conception of any chemical substance, requires definition of that substance other than by its functional utility."

In the instant application, a certain subset of specific SEQ ID NOs is described. Also, in

Vas-Cath Inc. v. Mahurkar (19 USPQ2d 1111, CAFC 1991), it was concluded that:

"...applicant must also convey, with reasonable clarity to those skilled in art, that applicant, as of filing date sought, was in possession of invention, with invention being, for purposes of "written description" inquiry, whatever is presently claimed."

In the application at the time of filing, there is no record or description which would demonstrate conception or description of any nucleic acids which are substantially identical to SEQ ID Nos: 1, 2, 7 and 8. This larger genus encompasses, according to the definition of the specification, anything which is at least 60% homologous with possible insertions and deletions. For example, with regard to SEQ ID NO: 1, which is 19 nucleotides in length, this would result in a requirement that only 60% or 11 nucleotides be constant. Assuming an upper size limit of 19, not present in the claim, is imposed on the variability, 8 positions which may vary remain. Thus, there are 4^8 possibilities, and the genus comprises 65,536 different oligonucleotides for which description of only 1 (ONE) is provided. Therefore, the claims fail to meet the written

description requirement by encompassing sequences which are not described in the specification.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-13, 15-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez et al (U.S. Patent 6,015,673) in view of Willhauck et al (Biotechniques (1998) 25:656-659).

Gonzalez teaches a method for determining the level of DPD gene expression in a tissue to determine the safety of a 5-fluorouracil based chemotherapeutic regimen comprising the steps: (see column 14, lines 41-51, also see column 27, lines 14-27, here the tissue is cultured fibroblasts derived from skin biopsies),

(a) obtaining a sample from a patient (column 14, lines 41-52)

(b) isolating mRNA from the sample (column 14, lines 52-67),

(c) amplifying the mRNA with primers which are substantially identical to SEQ ID

NO: 1 and 2 (see column 55, SEQ ID NO: 5)

a sequence, SEQ ID NO: 5, which is a sequence substantially identical to the claimed SEQ ID NO: 1 as shown in the alignment below.

```
Gonzalez SEQ ID NO: 5 - GCAAGGAGGGTTTGTCCTG
                        |||||
Claimed SEQ ID NO: 1 AGGAGCAAGGAGGGTTTG
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As the alignment shows, the Gonzalez sequence is 14/18 nucleotides identical to the claimed sequence, for a homology over the claimed sequence of 77%, which easily falls within the scope of at least 60% indicated by the specification as being required to meet the "substantially identical" language on page 9, line 14.

Further, all of the SEQ ID NO:s are substantially identical to the human DPD sequence disclosed in SEQ ID NO: 1 of U.S. Patent 5,856,454 and are derived from that sequence.

Gonzalez teaches freezing of the sample (see column 25, line 64) as well as fixing of the sample for detection (see column 13, lines 46-53).

Gonzalez teaches isolation of mRNA in the presence of Guanidine, a chaotropic agent (column 14, lines 52-67).

Gonzalez teaches that appropriate samples include any cells from the patient that may express the DPD gene (column 14, lines 41-51).

Gonzalez teaches a threshold for the mutation in which there is a problem tolerating 5-fluorouracil based chemotherapeutic regimens where a 2 fold difference will yield enhanced risk (see column 15, lines 1-11)

Gonzalez does not teach step (d) comparing the amount of DPD mRNA to the amount of mRNA of an internal control gene.


Willhauck teaches comparing the amount of the target gene to an internal control gene (see page 656, columns 1-3).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the internal controls of Willhauck in the method of

Gonzalez since Wilhauck states "Taken together our results show that the internal control circumvents a number of inherent problems of alternative controls to assess pre-PCR procedures. The overall RT-PCR assay sensitivity can be reliably evaluated on a per sample basis and the sensitivity limit of the RT-PCR assay can be assessed for every sample. This type of reliability can improve the homogeneity of results from clinical investigations in the future (page 658, column 3 to page 659, column 1)". An ordinary practitioner would have been motivated to use the internal controls of Wilhauck in the method of Gonzalez in order to reliably and sensitively improve the homogeneity of the clinical results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman
Primary Examiner
Art Unit 1637

October 24, 2002